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| APPLICATION NO.                                                                            | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------------|-------------|-----------------------------|---------------------|------------------|
| 10/536,582                                                                                 | 11/15/2005  | Harald Kollner              | 39611-99473         | 9215             |
| 23644 7590 07/11/2008<br>BARNES & THORNBURG LLP<br>P.O. BOX 2786<br>CHICAGO, IL 60690-2786 |             |                             |                     |                  |
| EXAMINER<br>KELLY, CATHERINE A                                                             |             |                             |                     |                  |
| ART UNIT<br>3634                                                                           |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>07/11/2008                                                            |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

### Office Action Summary

**Application No.**

10/536,582

**Applicant(s)**

KOLLNER ET AL.

**Examiner**

CATHERINE A. KELLY

**Art Unit**

3634

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 5/23/05
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the inner part of claim 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Clarifications***

1. Regarding 35 USC 112 paragraph 6. Examiner notes from Chapter 2100 of the current MPEP, section 2181:

*A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:*

- (A) the claim limitations must use the phrase "means for " or "step for ";*
- (B) the "means for " or "step for " must be modified by functional language; and*
- (C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function.*

With respect to the first prong of this analysis, a claim element that does not include the phrase "means for" or "step for" will not be considered to invoke 35 U.S.C. 112, sixth paragraph. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or (B) show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112 , sixth paragraph.

Since examiner cannot find clearly defined equivalents or definitions of "drive means" in the specification, examiner is considering the claims to include any structure capable of performing the function.

Guide means is modified by structure, so examiner assumes applicant is not invoking 112 6<sup>th</sup>.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 recites the limitation "the fixation point" in the third line. There is insufficient antecedent basis for this limitation in the claim. Claim 11 depends from claim 5 which does not include a fixation point. The fixation point is first claimed in claim 7.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-5, 9, 10, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6840012. The '012 reference shows the window winding arrangement of claim 1 in figure 1 where the drive means is motor 9 driving drum 8 with cable 5 around pulleys 6 and 7, cable 5 being attached to window pane 2 with link members 3 and 4 and guide means 10.

Regarding claim 3, the linear element is shown in the '012 reference in figure 1 reference numeral 5.

Regarding claim 4, the linear element as a pull cable is shown in the '012 reference in figure 1 reference numeral 5.

Regarding claim 5, the window winding arrangement used in a vehicle door is taught in the '012 reference in column 1 lines 9-13.

Regarding claim 9, the fixation part at force engagement points is shown in the '012 reference in figure 1 where the fixation parts are reference numerals 3 and 4.

Regarding claim 10, the deflection part roller is shown in the '012 reference in figure 1 reference numerals 6 and 7.

Regarding claim 13, the window winding arrangement for motor vehicle is shown in the '012 reference in figure 1 where the drive means is motor 9 driving drum 8 with cable 5 around pulleys 6 and 7, cable 5 being attached to window pane 2 with link members 3 and 4 and guide means 10 and the motor vehicle taught in column 1 lines 9-13.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6840012. The dual force points of claim 2 are taught in the '012 reference in column 4 lines 7-10 and column 8 lines 33-39. If applicant disagrees that these teachings read on claim 2, it further would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated because the '012 reference clearly sets out the differing loads on the force points and one of ordinary skill would have known at the time to vary the loads on the fixation points depending upon the desired objectives such as faster movement, lack of jamming, etc...

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6840012 as applied to claim 5 above and in further view of US PG Pub 2004/0163320. The '012 reference does not show the inner part of claim 6. This is shown in the '320 reference in figure 11 reference numeral 202 and the material of plastic is taught in paragraph [0038]. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine because carriers

or inner parts were known at the time to aid in the ease of assembly and repair of vehicle doors and their components which is always desirable in the art.

Regarding claim 7, examiner takes Official Notice that metal and plastic are known materials in the art. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine because metal and plastic are both very commonly used materials in the art, see use of plastic in the '320 reference above, and have known beneficial characteristic such as the strength and durability of metal and the lightweight of plastic as well as the ease of availability of both materials which are desirable in the art.

Regarding claim 8, the fixation part of the listed group is not shown in the '012 reference. A clip fixation part is shown in the '320 reference in figure 11 reference numeral 242. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine because a clip is known to provide a secure connection which is always desirable in the art.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6840012 as applied to claim 5 above, and further in view of US PG Pub 2002/0066232. The rail of claim 11 is not shown in the '012 reference. It is shown in the '232 reference in figure 2 where the fixation part is reference numeral 15 and the rail 20. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine because rails are known in the art to provide support to the fixation part and thus provide a more durable product which is always desirable in the art.



***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERINE A. KELLY whose telephone number is (571)270-3660. The examiner can normally be reached on Monday through Friday 8am - 4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. K./  
Examiner, Art Unit 3634

/KATHERINE W MITCHELL/  
Supervisory Patent Examiner, Art  
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